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John N. Gross

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN N. GROSS

Appeal 2009-002646
Application 10/770,937
Technology Center 3600

Decided: September 29, 2009

Before, MURRIEL E. CRAWFORD ANTON W. FETTING and JOSEPH
A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant has filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(3) (2007) of our Decision of March 30, 2009. In so doing, the Decision affirmed the rejections of claims 1-36 under 35 U.S.C. § 103(a) as unpatentable over the base combination of Hastings in view of Ostrom, and other various references applied to the dependent claims.

ANALYSIS

I. Appellant argues that "...the Board does not apparently realize is that Ostrom is *not* teaching anything beyond what is already shown in Hastings et al. The latter is directed to the operation of the Netflix website and Ostrom is merely cumulative and repetitive of Hasting et al.s' teachings." (Request 2). Appellant next states that "[t]he suggestion that Ostrom is teaching something new or different is completely mistaken." (Request 3). We disagree with Appellant because our use of Ostrom is driven by its more complete description of certain aspects of the prior art system, rather than by a difference in teaching as Appellant asserts. Since Ostrom is not incorporated by reference in Hastings, it must be relied on and applied as a separate reference.

II. Appellant argues that "[t]he Board confuses the re-ordering of the list with the act of making sure the list always '...include(s) at least one playable media item...'. " (emphasis added)(Request 3). However, the Appellant's arguments are not commensurate with the broader scope of claim 1 which recites

to automatically determine with said first computer if an

additional playable media item should be added to said subscriber delivery queue; and

(d) automatically modifying said subscriber delivery queue with said first computer to generate a new ordered list of one or more playable media items in response to the subscriber confirming that said additional playable media item can be included in said subscriber delivery queue.

Claim 1 (emphasis added)

Such language does not require that the list always include at least one playable media, as asserted by Appellant because the claim language is conditional upon a confirming response back from the subscriber as to whether to include the media or not. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

III. Appellant next asserts "... that the Board, like the Examiner, is trying to impart teachings/capabilities to Ostrom that are simply not there." (Request 3). We disagree with Appellant because the portion of the Decision which the Request points to here does not impart any teachings/capabilities to Ostrom, but rather is a reading of Ostrom based on the four corners of its disclosure and based on interpreting the claims using common sense. Specifically, as the list is decremented, it is modified to become a new list.

IV. Appellant reasserts the argument made in their Brief that "the act of sending the next movie, even if it 'modifies' the list, does not cause the subscriber delivery queue to be '*...maintained automatically for the subscriber so as to include at least one playable media item* which could be delivered to such subscriber.'" (Request 3). Again, the Board directs Appellant to pages 13 and 14 of its Decision and to its analysis and consequential findings that in Hastings "the MAX TURNS mode insures

that for a given cycle, and for however many number of overrides occur, at least one playable media can be delivered to a subscriber.” (Decision, p. 14).

V. Appellant next argues that, “...there is no teaching, motivation or suggestion in the references to change the underlying behavior of Hastings et al. to include this type of operation. The Examiner and the Board do not dispute this lack of evidence.” (Request 4). We disagree with Appellant. Nowhere in our Decision do we admit such a lack of evidence. More important, Appellant here presents for the first time an argument to the lack of teaching, motivation or suggestion for a majority of the claims. The only instance of such an argument being made in the Brief was on page 13 directed to only claim 16 and Kamel, and was not, as now, made to the general combination of Hastings and Ostrom. The Decision nevertheless points out that “[t]o the extent Appellant seeks an explicit suggestion or motivation in the reference itself, this is no longer the law in view of the Supreme Court’s recent holding in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).” (Decision 17).

VI. Appellant argues that with respect to our interpretation of Hastings, and how we have interpreted the MAX TURNS disclosures at pages 13 and 14 of our Decision, that such different interpretation constitutes a new ground of rejection because the “rejection is based on a new claim interpretation not previously presented to Appellant during prosecution...” and Appellant thus far has not “had a fair opportunity to react to the rejection.” (Request 6). Since our interpretation differs from that taken by the Examiner, and Appellant has not had the opportunity to rebut same, we thus modify our Decision to designate it as a new ground of rejection under 37 C.F.R. § 41.50(b).

VII. Appellant's arguments to claims 9-14, and 16-19 are new, and were not presented in their Brief and thus will not be considered now.

VIII. Appellant argues that he argued claim 36 with specificity in his Brief. (Request 19). The sum total of Appellant's argument in his Brief to claim 36 was to repeat the limitations of the claims which we do not consider to be a reasonably specific argument. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See, 37 C.F.R. § 41.37 (c)(1)(vii) (2004).

DECISION

Our decision to affirm the decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 103(a) over Hastings in view of Ostrom and various other references used to reject dependent claims has not been shown to have been erroneous. However, because in so affirming we used a different rationale than that articulated by the Examiner, we grant the request for rehearing only to the extent that we denominate the Decision a new ground of rejection under 37 C.F.R. § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REHEARING GRANTED
ONLY AS TO DENOMINATE
A NEW GROUND OF REJECTION UNDER 37 CFR 41.50(b)

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